

ESTTA Tracking number: **ESTTA139581**

Filing date: **05/09/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	ALBERTO-CULVER INTERNATIONAL, INC. Alberto-Culver International, Inc.
Granted to Date of previous extension	05/09/2007
Address	2525 Armitage Avenue Chicago, IL 60160 UNITED STATES
Party who filed Extension of time to oppose	ALBERTO-CULVER COMPANY Alberto-Culver Company
Relationship to party who filed Extension of time to oppose	Alberto-Culver International, Inc. is the direct successor-in-interest by assignment of the pertinent trademark rights formerly owned by Alberto-Culver Company.

Attorney information	Craig S. Fochler Foley & Lardner LLP 321 North Clark Street Suite 2800 Chicago, IL 60610-4764 UNITED STATES cfochler@foley.com, cmandly@foley.com, edepakakibo@foley.com Phone:312.832.4500
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Applicant Information

Application No	78904064	Publication date	01/09/2007
Opposition Filing Date	05/09/2007	Opposition Period Ends	05/09/2007
Applicant	998232 Alberta Ltd. 5923 3rd Street SE Calgary, T2H1K3 CANADA		

Goods/Services Affected by Opposition

Class 003.

All goods and services in the class are opposed, namely: Skin gels for accelerating, enhancing or extending tans; Sun block; Sun block preparations; Sun care lotions; Sun creams; Sun screen; Sun screen preparations; Sun tan gel; Sun tan lotion; Sun tan oil; Sun-block lotions; Tanning creams

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Dilution	Trademark Act section 43(c)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	822537	Application Date	08/18/1965
Registration Date	01/17/1967	Foreign Priority Date	NONE
Word Mark	VO5		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class U051 (International Class 003). First use: First Use: 1955/03/01 First Use In Commerce: 1955/03/01</p> <p>PREPARATIONS FOR THE HAIR, INCLUDING PERMANENT WAVE LOTION, HAIR SPRAY, SETTING LOTION, CREME RINSE, DRESSING AND CONDITIONER, HAIR BRIGHTENER, AND CONDITIONER FOR COLORED HAIR</p> <p>Class U052 (International Class 003). First use: First Use: 1963/04/19 First Use In Commerce: 1963/04/19</p> <p>HAIR SHAMPOO, AND SHAMPOO CONCENTRATE</p>		

U.S. Registration No.	1449193	Application Date	12/22/1986
Registration Date	07/28/1987	Foreign Priority Date	NONE
Word Mark	VO5		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1986/12/01 First Use In Commerce: 1986/12/01</p> <p>HAIR STYLING MOUSSE AND HAIR STYLING GEL</p>		

U.S. Registration No.	658904	Application Date	06/20/1956
Registration Date	02/25/1958	Foreign Priority Date	NONE
Word Mark	ALBERTO VO5		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class U051 (International Class 003). First use: First Use: 1939/01/00 First Use In Commerce: 1939/01/11</p> <p>PREPARATION USED AS A HAIR DRESSING AND AS A HAIR SCALP CONDITIONER</p>		

U.S. Registration No.	723187	Application Date	01/30/1961
Registration Date	10/24/1961	Foreign Priority Date	NONE
Word Mark	ALBERTO VO5		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U051 (International Class 003). First use: First Use: 1960/11/30 First Use In Commerce: 1960/11/30 Hair Spray

U.S. Registration No.	3078626	Application Date	07/01/2004
Registration Date	04/11/2006	Foreign Priority Date	NONE
Word Mark	ALBERTO VO5		
Design Mark			
Description of Mark	The mark consists of the words ALBERTO VO5 in stylized form shown on a design of a shield.		
Goods/Services	Class 003. First use: First Use: 1994/06/00 First Use In Commerce: 1994/06/00 Hair care preparations		

U.S. Application No.	78508569	Application Date	10/29/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ALBERTO VO5		
Design Mark			
Description of Mark	The mark consists of stylized lettering using the "Optima" font family, shown in white on a dark blue background of a flag design, which includes ribbons applied to the top and bottom in metallic silver. The color red is applied to the triangular shape inserted into the letter "V".		
Goods/Services	Class 003. First use: First Use: 2005/01/01 First Use In Commerce: 2005/01/01 Hair care preparations		

U.S. Application No.	78508570	Application Date	10/29/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ALBERTO VO5		
Design Mark			
Description of Mark	The mark consists of stylized lettering using the "Optima" font family on a flag design, including ribbons applied to the top and bottom.		
Goods/Services	Class 003. First use: First Use: 2005/01/01 First Use In Commerce: 2005/01/01 Hair care preparations		

Attachments	78444904#TMSN.jpeg (1 page)(bytes) 78508569#TMSN.jpeg (1 page)(bytes) 78508570#TMSN.jpeg (1 page)(bytes) 3VO.pdf (4 pages)(49926 bytes)
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Signature	/Charles R. Mandly, Jr./
Name	Charles R. Mandly, Jr.

Date	05/09/2007
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Mark: 3VO
Serial Number: 78/904,064
Filed: June 8, 2006
Published: January 9, 2007

ALBERTO-CULVER INTERNATIONAL, :
INC., :

Opposer

v.

Opposition No. _____

998232 ALBERTA LTD.,

Applicant.

Opposer, Alberto-Culver International, Inc., a Delaware corporation, the direct successor-in-interest by assignment of the pertinent trademark rights formerly owned by Alberto-Culver Company, believes that it will be harmed by the issuance of a registration for Application Serial Number 78/904,064, and hereby opposes such application.

As grounds for the opposition, Alberto-Culver International, Inc. alleges the following:

1. For years, Alberto-Culver International, Inc., including its predecessors-in-interest (collectively "Alberto"), has been engaged, either directly or through related companies, in the business, *inter alia*, of manufacturing and selling a wide variety of personal care products, including hair care preparations and skin care preparations, to the general public at various locations throughout the United States.

2. Since at least as early as the 1930's, long prior to the filing of the application opposed herein, Alberto, either directly or through related companies, has sold personal care

products under a set of invented or “coined” marks consisting, in whole or in part, of the letter combination “VO” in conjunction with the Arabic numeral “5” (collectively “VO5 Marks”).

3. Alberto has registered its VO5 Marks with the United States Patent and Trademark Office, including the following:

Mark	Registration Number	Registration Date	Goods/Services
VO5	822,537	January 17, 1967	Preparation for the hair, including permanent wave lotion, hair spray, setting lotion, crème rinse, dressing and conditioner, hair brightener, and conditioner for colored hair.
VO5	1,449,193	July 28, 1987	Hair styling mousse and hair styling gel.
ALBERTO VO5	658,904	February 25, 1958	Preparation used as a hair dressing and as a hair scalp conditioner
ALBERTO VO5	723,187	October 24, 1961	Hair spray
ALBERTO VO5 & Design	3,078,626	April 11, 2006	Hair care preparations

Said registrations are valid, subsisting and owned by Alberto, and Registration Nos. 822,537, 1,449,193, 658,904, and 723,187, are each incontestable in accordance with Sections 8 and 15 of the United States Trademark Act, 15 U.S.C. §§ 1065 & 1115(b).

4. Alberto owns an invaluable goodwill represented by each of its VO5 Marks for personal care products comprising, *inter alia*, lotions, gels and creams.

5. Applicant, 998232 Alberta Ltd. (“Alberta”), upon information and belief, is engaged, or intends to engage, in the business of selling personal care products, namely skin care preparations comprising, for the most part, lotions, gels and creams.

6. Alberta has applied to register (United States Trademark Application Serial No. 78/236,671) the trademark 3VO (stylized) for “skin gels for accelerating, enhancing or extending tans; sun block; sun block preparations; sun care lotions; sun creams; sun screen; sun screen preparations; sun tan gel; sun tan lotion; sun tan oil; sun block lotions; tanning creams.

7. Upon information and belief, prior to June 8, 2006, Alberta made no use of the trademark 3VO for any of the aforesaid lotion, gel or cream personal care products or any other personal care products.

8. Registration of Alberta’s aforesaid mark 3VO for the aforesaid personal care products is likely to confuse the public as to the source of Alberta’s products in violation of Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

9. Each of Alberto’s VO5 Marks inherently is a highly distinctive mark.

10. Through long and substantial sales and advertising of VO5 branded goods, and since long prior to June 8, 2006, as well as, upon information and belief, long prior to any of Alberta’s use of the mark 3VO for the aforesaid personal care products, each of Alberto’s VO5 Marks acquired a high degree of acquired distinctiveness or secondary meaning symbolizing an invaluable goodwill owned by Alberto.

11. Since long prior to June 8, 2006, and upon information and belief, long prior to any of Alberta’s use of the mark 3VO for the aforesaid personal products, each of Alberto’s VO5 Marks had become famous within the meaning of Section 43(c) of the United States Trademark Act, 15 U.S.C. § 1125(c).

12. Any use of the 3VO mark for the aforesaid personal care products is likely to dilute the distinctive quality of each of Alberto’s VO5 Marks.

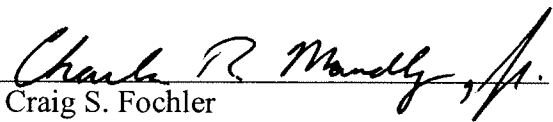
WHEREFORE, Alberta is not entitled to register the trademark 3VO, and any such registration would be damaging to Alberto.

Alberto herewith submits the requisite filing fee in the sum of \$300.00. Please deduct any underpayment of requisite fees or credit any over payment to the deposit account of Foley & Lardner, LLP, Account No. 06-1450.

Please address all communications to Craig S. Fochler, Foley & Lardner LLP, 321 North Clark Street, Suite 2800, Chicago, Illinois 60610-4764; Telephone No. (312) 832.4379.

Respectfully submitted,

FOLEY & LARDNER LLP

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Attorneys for Opposer
ALBERTO-CULVER COMPANY